

form on January 15, 2003. The April 3, 2003 Official Action now newly rejects claim 12 under 35 USC 102(b) as being anticipated by McCormack. Likewise, claim 14 was originally rejected under 35 USC 103 as being unpatentable by Hardy in view of McCormack and further in view of Cady. Claim 14 was then presented in independent form. Claim 14 is now newly rejected over the combination of McCormack, Caddaye and Hardy. Under the circumstances, the Examiner's Official Action should not have been made final. Therefore, reconsideration and withdrawal of the finality of the April 3, 2003 Official Action is respectfully requested.

Claim 12 has been rejected under 35 USC 102(b) as being anticipated by McCormack. Applicant respectfully traverses this rejection.

Anticipation under Section 102 of the Patent Act requires that a prior art reference disclose every claim element of the claimed invention. See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1574 (Fed. Cir. 1986). While other references may be used to interpret an allegedly anticipating reference, anticipation must be found in a single reference. See, e.g., Studiengesellschaft Kohle, G.m.b.H. v. Dart Indus., Inc., 726 F.2d 724, 726-27 (Fed. Cir. 1984). The absence of any element of the claim from the cited reference negates anticipation. See, e.g., Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715 (Fed. Cir. 1984). Anticipation is not shown even if the differences between the claims and the prior art reference are insubstantial and the missing elements could be supplied by the knowledge of one skilled in the art. See, e.g., Structural Rubber Prods., 749 F.2d at 716-17.

In the Official Action, the Examiner asserted that "McCormack inherently discloses his second base supported on an opposite side of the base unit remote from the first base since McCormack discloses the assembly is modular... and can therefore be replicated in either direction." Applicant respectfully but strongly disagrees. Although McCormack discloses that the assembly is modular, McCormack in no way

teaches or suggests that "base unit 11" may be replicated in either direction. Indeed, this interpretation of McCormack is an interpretation derived from the Examiner based solely on his hindsight knowledge of the invention. The fact that McCormack teaches a modular unit does not in any way suggest that his "head stock base 11" could or should be duplicated. In fact, the skilled artisan would never duplicate base unit 11 because base unit 11 is provided as a head stock base and McCormack does not teach or suggest that more than one head stock should be included in his lathe assembly.

Because McCormack does not teach or suggest the replication of his assembly as alleged by the Examiner and certainly does not teach or suggest the provision of more than one of his "base units 11", McCormack cannot properly be said to anticipate the invention. Reconsideration and withdrawal of the rejection of claim 12 is requested.

Claim 15 was rejected under 35 USC 103(a) as unpatentable over Hardy in view of McCormack. Applicant respectfully traverses this rejection.

In order to prove obviousness, a challenger must present prior art references which disclose the claimed subject matter of the patent/application in question. If separate prior art references each disclose separate elements of a claim, the challenger must also show some teaching, suggestion, or incentive in the prior art that would have led one of ordinary skill in the art to make the claimed combination. See, e.g., Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 304-05 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). In determining obviousness, there must be some reason other than hindsight for selectively combining the prior art references to render the claimed invention obvious. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

The Examiner acknowledges that neither Hardy nor McCormack teach the claimed spring-biased pin but summarily concludes that it would be "obvious" to

"redesign" the threaded pin of Hardy to be a spring biased pin. Applicant respectfully completely disagrees with the Examiner's determination.

Hardy teaches a lathe assembly having a head stock assembly 16, a conventional bed 10 and a tailstock 12 in a fixed, integrated combination.

McCormack relates to a wood lathe having a head stack detachably secured to a base 11 and including bed sections that are detachably secured to the head stock base. The Examiner, noting the limitations of applicant's claims, summarily concludes that it "would have been obvious" to modify Hardy to include a second lathe bed as taught by McCormack. Applicant respectfully disagrees. As noted above, Hardy teaches a conventional bed 10 disposed between a fixed head stock 16 and a tail stock 12. McCormack relates to an entirely different, modular wood lathe wherein essentially all component parts of the lathe, including the head stock, are detachably secured together in various configurations and/or with spacers to modify the relative position of the components. As Hardy's components are not taught as being detachably secured together, it is not self evident nor would the skilled artisan find it "obvious" to provide a "second bed" for being attached to Hardy. In fact, it is unclear how such a second bed could be attached to Hardy's assembly, or what function it could provide in view of the fixed mounting and orientation of the head stock and tail stock in Hardy. Clearly the Examiner has proposed a complete redesign of Hardy with no motivation other than the benefit of knowledge of applicant's disclosure and claims. The skilled artisan without the benefit of applicant's disclosure would not "obviously" provide an isolated component of McCormack -a second bed assembly- in the Hardy assembly. Indeed, there is no apparent use or advantage to a second bed assembly in the conventional fixed placement lathe of Hardy. Rather, the skilled artisan would use these assemblies in the alternative. It is therefore respectfully submitted that the Examiner's proposed combination Hardy and McCormack is without motivation in the prior art of record.

Furthermore, as noted above, the Examiner acknowledges that Hardy/McCormack does not teach a spring biased pin as claimed in claim 15, and the Examiner has cited no evidence whatsoever in support of his suggestion that it would be "obvious" to redesign the threaded pin of Hardy to be a spring biased pin. Thus, the Examiner has provided no evidence whatsoever that it would be obvious to modify the Hardy/McCormack combination to include the claimed spring biased pin. Inasmuch as a spring biased pin is structurally and functionally materially different from a threaded pin of the type taught by Hardy, the Examiner's summary conclusion of obviousness is improper under 35 USC 103. The Examiner's suggestion that the invention "would perform equally well with a threaded fastener" is not well taken and is not the test for patentability. The fact is, the structure claimed by applicant is different from the prior art cited by the Examiner and the Examiner has not cited evidence in support of his otherwise unsubstantiated conclusion that it would be "obvious" to modify Hardy to produce the invention claimed. This is particularly true since a spring biased fastener and a threaded fastener operate in a materially different manner.

Rejections based on 35 USC §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has initial duty of supplying the factual basis for the rejection. The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Wanery, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967)..

Because none of the references of record discloses the details of the claimed invention lacking in the applied references, nor the unique advantages thereof, there can be no suggestion to modify the structure to contain those features. See In re Civitello, 339 F.2d 243, 144 USPQ 10, (CCPA 1964).

Claims 14, 16, 18 and 19 were rejected under 35 USC 103(a) as being unpatentable over McCormack in view of Caddaye and further in view of Hardy. Applicant respectfully traverses this rejection.

The Examiner has asserted that it would be "obvious" to provide a slidable tailstock in McCormack in view Caddaye and that it would be "obvious" to form the tailstock to an elliptical shape in view of Hardy. Applicant respectfully submits that the Examiner's proposed prior art combination is not a combination that would be made by the skilled artisan in the absence of applicant's disclosure and, thus, the Examiner's proposed rejection is improper under 35 USC 103.

Section 103 does not allow the Examiner to engage in picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1975).

As the CAFC has said, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems v Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984). There must be a suggestion in the art relied upon to use what one reference discloses in or in combination with the disclosure of the other reference or references relied upon by the Examiner. In re Grabiak, 226 USPQ 870, 872 (Fed. Cir. 1986).

Caddaye teaches a tailstock 23 slidably mounted to a lathe bed 22. As shown in Figure 1 a locking mechanism is provided to lock the tailstock in a selected position along the length of the lathe bed 22. Caddaye discloses a tailstock 23 that is generally box-like and rectangular in vertical section, consistent with the remainder of his lathe apparatus. McCormack also teaches a wood lathe assembly composed of generally flat planar components. The Examiner asserts that it would be obvious to incorporate a

tailstock as shown in Caddaye in McCormack, but recognizes that even if such a combination were made, the limitations of applicant's claims 14, 16, 18 and 19 would still not be anticipated nor obvious because those references do "not explicitly state that [the] tailstock... has a generally circular transverse cross-section and generally elliptical longitudinal section." The Examiner concludes, however, that because Hardy allegedly teaches a tailstock that is elliptical in longitudinal section and circular in cross-section, it would have been obvious to reshape the tailstock of McCormack/Caddaye to correspond to that of Hardy. Applicant respectfully disagrees.

Firstly, it is noted that Hardy predates McCormack by over 35 years. Moreover, Hardy does not relate to a modular mechanism nor a slidable tailstock assembly. Indeed, it is not self-evident how the configuration of Hardy's tailstock could be readily and easily adapted to be slidable tailstock of Caddaye such as to include the Caddaye locking mechanism illustrated in Figure 1. Moreover, because no cross-sectional view of the tailstock of Hardy is provided nor any explanation or even comment on the configuration of this part, there is no teaching evident in Hardy that would motivate the skilled artisan to modify the McCormack/Caddaye combination. It is therefore respectfully submitted that the only motivation for the Examiner's modification of the McCormack/Caddaye combination is his hindsight knowledge of particulars of the unique and advantageous assembly proposed by applicant including an ergonomic and aesthetically pleasing tailstock assembly.

Claim 18 is also submitted to be distinct from the applied art in its own right because McCormack does not teach or suggest a second base unit as claimed therein. As noted above with regard to claim 12, McCormack does not teach or suggest a second "base unit 11". Furthermore, the Examiner's suggestion that McCormack discloses a second base unit "36" is submitted to be without merit. Indeed, element 26 is not a second base unit and does not support a longitudinal end of a second lathe bed assembly remote from a "first base unit". Element 36 of McCormack is nothing more than an adapter bracket and a fair reading thereof cannot equate such a structure with

a base unit as recited in applicant's claims. Moreover, bracket 36 of McCormack is not mounted to an end of a second lathe bed assembly remote from a first base unit as defined in applicant's claim. Clearly, bracket 36 is mounted to, not remote from, the one and only base unit of McCormack.

For all the reasons advanced above, reconsideration and withdrawal of the rejection of claims 14, 16, 18 and 19 is requested.

Claims 20 and 21 were rejected under 35 USC 103 as being unpatentable over Hardy in view of McCormack and further in view of Clay. Applicant respectfully traverses this rejection.

The Examiner's combination of Hardy and McCormack is respectfully traversed for the reasons advanced above with regard to claim 15. Indeed, as noted above, Hardy teaches a conventional, fixed lathe bed disposed between a fixed head stock and a fixed tail stock. As Hardy's components are not taught as being detachably secured together it is not self evident nor would the skilled artisan find it "obvious" to provide a second lathe bed to some how to be attached to Hardy. The skilled artisan would use McCormack and Hardy in the alternative and would not attempt a combination of the same as suggested by the Examiner. The Examiner's further reliance on Clay does not overcome the deficiencies of the Hardy/McCormack combination noted above.

Furthermore, with regard to claim 20, it is respectfully noted that the tool rest assembly recited in claim 20 includes a slider block and a non-circular locking shaft that extends longitudinally of the housing and is disposed through a bore in the slider block. Clay differs from the invention in this regard because Clay does not teach a slider block having a bore. Rather, Clay provides a support block 12 on which a cam 13-15 is rotatably disposed. Thus, it can be seen that Clay is far more complex than the invention and does not comprise the components recited in applicant's claim 20. As such, Clay does not anticipate the tool rest recited in claim 20 and there is no teaching

WIRTH et al
Serial No. **09/922,938**
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or suggestion in the record prior art of modifying Clay so as to produce the invention claimed. Claim 21 is patentable over the record art for the same reasons.

Applicant notes with appreciation the Examiner's indication that claims 1-10 are allowed. For the reasons advanced above, however, reconsideration and withdrawal of the prior art rejections of claims 12, 14-16 and 18-21 is respectfully requested.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

Respectfully submitted,

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